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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,309	01/15/2002	Jon Sanders	0184-2001	5160

7590

12/04/2003

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EXAMINER
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LEE, PING

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 12/04/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/047,309

Applicant(s)

SANDERS, JON

Examiner

Ping Lee

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, this is an improper claim because it has improper dependency.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Marshak (US Des. 280,897).

Marshak shows a template (front panel) comprising a template blank shaped for accommodation by an amplifier control panel (although not shown, the template in the figure is be attached to a panel having a plurality of control switches) and the template blank comprising a surface for marking control settings (scale) and related indicia.

An intended use (for recording custom settings on an audio amplification system or components thereof) clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Thus, a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, supra at 480; *Ex parte Mott* 190 USPQ 311, 313 (PTO Bd. of App. 1975).

Marshak's template reads on the claimed removable template. As indicated in the figure and the title of Marshak's invention, the template is a front panel of the audio equipment. Marshak indicates that the front panel is a separate piece from the rest of the mixer and therefor, it is removable piece from the rest of the mixer.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshak.

Marshak fails to explicitly show how to removable attach the template to the control panel. As indicated in the figure and the title of Marshak's invention, this is a front panel of the audio equipment. Marshak indicates that the front panel is a separate piece from the rest of the mixer and therefor, it is removable piece from the rest of the mixer. One skilled in the art would have expected the front panel has to be fixed to the equipment. It was well known in the art to use some kind of adhesive to attach one component to the other component. Thus, it would have been obvious to one of ordinary skill in the art to modify Marshak's template by using an adhesive to removable attach the template to the control panel.

7. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder (US 4,677,674) in view of Challoner.

Regarding claims 1, 3, 9 and 11, Snyder teaches that one way to record the setting is to record the setting manually (col. 1, lines 38-41). Snyder's teaching implies that a user uses a paper (or other similar device) and writing equipment (pen or pencil or the like) to write down the setting. Snyder fails to show a template having a plurality of openings dimensioned and arranged to fit over the controls. It was a common practice among people to use a paper and pencil to write down the setting. As taught in Challoner, there are several ways to write down the change of positions. For example, on p. 21, Challoner teaches how to use a paper (having a color) and a pencil to mark down the first position of the control (the toothpick). Since the paper is being placed and aligned with the control (the toothpick), the data can be written down easily and quickly. Other paper could be used to measure other objects (other than marbles). The

paper measured the marble was reusable. It could be placed at the same location as the marble scale. On pps. 28-29, Challoner teaches how to cut out an opening dimensioned to fit over the control (the red pencil in the middle). Another pencil is used to write down the change of the position of the shadow.

The present invention is a modification of a sheet of paper with custom-made holes according to the locations and dimensions of the controls. Since the openings are custom-made, the same sheet cannot be used for other type of control panels having different control switches. This modification is merely design choice based on the specific application. For example, the paper with the custom cut out holes for the control panel of a mixer cannot be fitted over the control panel of an equalizer. Thus, it would have been obvious to one of ordinary skill in the art to modify Snyder in view of Challoner by having a paper with custom-made cutout holes according to the size and location of the controls to be fitted over in order to easily and quickly write down the setting.

Regarding claims 2, 4, 5, 10, 12 and 13, although Challoner fails to show that the template is produced from plastic stock, metal stock or foam stock, those are well known material for making a template just as a sheet of paper. Thus, it would have been obvious to one of ordinary skill in the art to use any of plastic stock, metal stock or foam stock to make a template because it was considered as a matter of engineering design choice to make a template using a specific kind of material without generating any unexpected result.

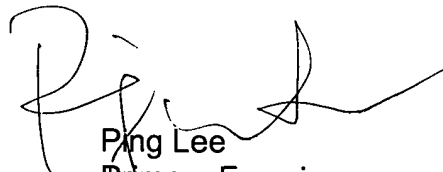
Regarding claims 6, 7, 14 and 15, Challoner teaches the adhesive.

Regarding claims 8 and 16, Snyder and Challoner fail to show the magnetically backed template. However, it was well known to those in the art to secure a sheet to a panel using the magnet. Thus, it would have been obvious to one of ordinary skill in the art to modify the template by making the template having magnetic backing in order to secure it to the control panel without using a tape as taught in Challoner.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ping Lee whose telephone number is 703-305-4865. The examiner can normally be reached on Monday and Tuesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

  
Ping Lee  
Primary Examiner  
Art Unit 2644

pwl  
December 1, 2003